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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/049,696	03/27/1998	PATRICIA A. BILLING-MEDEL	6067.US.O1	5914

23492 7590 12/17/2004

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ABBOTT PARK, IL 60064-6008

EXAMINER

MARTINELL, JAMES

ART UNIT PAPER NUMBER

1631

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/049,696

Applicant(s)

BILLING-MEDEL ET AL.

Examiner

James Martinell

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-38 and 40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-38 and 40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The indicated allowability of claim 40 is withdrawn in view of the newly discovered reference(s) to Tang et al (U.S. 2001/0025098). Rejections based on the newly cited reference(s) follow.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 33-38 and 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tang et al (U.S. 2001/0025098). SEQ ID NOs: 18, 19, and 20 are contained within SEQ ID NO: 25 of Tang et al (U.S. 2001/0025098). See the alignments in Appendices A, B, and C of this Office action. None of SEQ ID NOs: 18, 19, or 20 has basis in parent application Serial No. 08/829,754, so the effective filing date of each of the instant claims is March 27, 1998. SEQ ID NO: 25 of Tang et al (U.S. 2001/0025098) has basis in Serial No. 09/039,307 (filed March 13, 1998) as SEQ ID NO: 24. In addition, Tang et al teaches the expression of the DNAs disclosed in Tang et al in heterologous hosts (*e.g.*, see paragraphs 0167-0182), thus meeting claims 35-37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719. The fax phone number for Examiner Martinell's desktop workstation is (571) 273-0719. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a

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return telephone call may be e-mailed to james.martinell@uspto.gov. Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (571) 272-0722.


FAX NUMBER

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.


James Martinell, Ph.D.
Primary Examiner
Art Unit 1631

12/11/04

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Db      2291 CCTGGCCAAATCACCAGCCTGAGGCGGAAATTCACGGGGGAGTCTCATTAATCTGACT 2350
QY      TGGACAGCTCTCTGGGATGATATGACCATGGAACAGCTCAAGATATATCATTCGAATA 2400
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Db      2411 AGTACAAGTATCTTGAATCTCAGAGACAAGTTCATTAATCTCTTCAAGTGAATACTACT 2470
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Db      2771 ATAGCTAGGCTGAATTTTGTGATGAATATTAATATTAATATTCATCTT 2822

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RESULT 2

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US-09-823-356-25
; Sequence 25, Application US/09823356
; Patent No. US20010025098A1
; GENERAL INFORMATION:
; APPLICANT: Tang, Y. Tom
; APPLICANT: Bandman, Olga
; APPLICANT: Lal, Preeti
; APPLICANT: Hillman, Jennifer L.
; APPLICANT: Yue, Henry
; APPLICANT: Corley, Neil C.
; APPLICANT: Guegler, Karl J.
; APPLICANT: Kaser, Matthew R.
; APPLICANT: Baughn, Mariah R.
; APPLICANT: Shah, Purvi
; TITLE OF INVENTION: HUMAN MEMBRANE SPANNING PROTEINS
; FILE REFERENCE: PF-0489-1 CON
; CURRENT APPLICATION NUMBER: US/09/823,356
; PRIOR FILING DATE: 2001-03-30
; PRIOR APPLICATION NUMBER: 09/039,307
; PRIOR FILING DATE: 1998 March 13
; NUMBER OF SEQ ID NOS: 34
; SOFTWARE: PERL Program
; SEQ ID NO 25
; LENGTH: 3111
; TYPE: DNA
; ORGANISM: Homo sapiens
; FEATURE:
; NAME/KEY: misc feature
; OTHER INFORMATION: Incyte ID No. US20010025098A1 173775
US-09-823-356-25

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Query Match 100.0%; Score 2812; DB 9; Length 3111;
Best Local Similarity 100.0%; Pred. No. 0;
Matches 2812; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
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1681 GTA 1683
2844 GTA 2846

RESULT 2

US-09-823-356-25
; Sequence 25, Application US/09823356
; Patent No. US20010025098A1
; GENERAL INFORMATION:
; APPLICANT: Tang, Y. Tom
; APPLICANT: Bandman, Olga
; APPLICANT: Lal, Preeti
; APPLICANT: Hillman, Jennifer L.
; APPLICANT: Yue, Henry
; APPLICANT: Corley, Neil C.
; APPLICANT: Guegler, Karl J.
; APPLICANT: Kaser, Matthew R.
; APPLICANT: Baughn, Mariah R.
; APPLICANT: Shah, Purvi
; TITLE OF INVENTION: HUMAN MEMBRANE SPANNING PROTEINS
; FILE REFERENCE: PF-0489-1 CON
; CURRENT APPLICATION NUMBER: US/09/823,356
; CURRENT FILING DATE: 2001-03-30
; PRIOR APPLICATION NUMBER: 09/039,307
; PRIOR FILING DATE: 1998 March 13
; NUMBER OF SEQ ID NOS: 34
; SOFTWARE: PERL Program
; SEQ ID NO 25
; LENGTH: 3111
; TYPE: DNA
; ORGANISM: Homo sapiens
; FEATURE:
; NAME/KEY: misc_feature
; OTHER INFORMATION: Incyte ID No. US20010025098A1 1737775
US-09-823-356-25

Query Match 100.0%; Score 1683; DB 9; Length 3111;
Best Local Similarity 100.0%; Pred No. 0;
Matches 1683; Conservative 0; Mismatches 0; Indels 0; Gaps 0;
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APPENDIX B 1/2

APPENDIX B Y_2

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Qy	421	AC	AG	T	C	G	A	G	C	A	G	T	C	A	A	A	C	T	T	G	A	C	C	T	G	A	C	T	G	A	C	T	G	A	480	
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Qy	481	CT	AC	C	C	T	G	C	T	C	C	A	T	T	A	C	A	G	T	C	C	A	A	A	C	A	A	A	C	A	A	A	T	C	C	540
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Qy	541	GC	C	T	C	T	G	T	A	G	T	T	A	T	G	C	A	A	T	T	G	C	A	A	G	A	G	C	T	C	C	C	A	A	T	600
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Qy	601	TC	AC	AG	C	C	C	T	G	A	T	CA	G	T	GA	A	T	GG	A	A	A	A	C	A	G	T	T	AC	T	T	GG	A	A	C	A	660
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Db	2510	TGTTTAAACCAAGAAACATTACTTTTGAAATGSCACAGATCTTTTTCATTTGCTATTTCAGG	2569
Qy	1261	CTGTTGATAGGTCGATCTGAAATCAGAAATATCCAAATTCGACGAGTATCTTTTGTTTA	1320
Db	2570	CTGTTGATAGGTCGATCTGAAATCAGAAATATCCAAATTCGACGAGTATCTTTTGTTTA	2629
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Qy	1501	TCATTCATCCTTTTTTTTGTGATTATAAAATTTTCTAAAAATGATTTTAGACTTCTGTAGG	1560
Db	2810	TCATTCATCCTTTTTTTTGTGATTATAAAATTTTCTAAAAATGATTTTAGACTTCTGTAGG	2869
Qy	1561	GGGCGATATACTAAATGTATATAGTACATTTTACTAAATGTATCTGTAGGGGGCGAT	1620
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US-09-981-353-191

; Sequence 191, Application US/09981353

; Patent No. US20020160382A1

; GENERAL INFORMATION:

; APPLICANT: Lasek, Amy W.

; APPLICANT: Jones, David A.

; TITLE OF INVENTION: GENES EXPRESSED IN COLON CANCER

; FILE REFERENCE: PA-0038 US

; CURRENT APPLICATION NUMBER: US/09/981,353

; CURRENT FILING DATE: 2001-10-11

; NUMBER OF SEQ ID NOS: 194

; SOFTWARE: PERL Program

; SEQ ID NO 191

; LENGTH: 3111

; TYPE: DNA

; ORGANISM: Homo sapiens

; FEATURE:

; NAME/KEY: misc_feature

; OTHER INFORMATION: Incyte ID No. US20020160382A1 1737775CB1

US-09-981-353-191

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GenCore version 5.1.6
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OM nucleic - nucleic search, using sw model

Run on: October 18, 2004, 14:21:36 ; Search time 930.916 Seconds
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Perfect score: 2983

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Gapop 10.0 , Gapext 1.0

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Pred. No. is the number of results predicted by chance to have a score greater than or equal to the score of the result being printed, and is derived by analysis of the total score distribution.

SUMMARIES

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2	2983	100.0	3111	9	US-09-981-353-191
3	2983	100.0	3111	15	US-10-235-994-25
4	2983	100.0	3267	9	US-09-764-868-22
5	2971.8	99.6	3007	14	US-10-055-412B-27
6	2966.2	99.4	3311	9	US-09-922-217-1056
7	2966.2	99.4	3311	9	US-09-833-263-1056
8	2966.2	99.4	3311	13	US-10-025-380-1056
9	2966.2	99.4	3311	15	US-10-393-590-11
10	2966.2	99.4	3311	15	US-10-393-590-12
11	2966.2	99.4	3311	15	US-10-393-590-46
12	2966.2	99.4	3311	15	US-10-393-590-47
13	2966.2	99.4	3311	15	US-10-393-567-11

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15 2966.2 99.4 3311 15 US-10-393-567-46 Sequence 46, Appl
16 2966.2 99.4 3311 15 US-10-393-567-47 Sequence 47, Appl
17 2966.2 99.4 3311 15 US-10-394-087-11 Sequence 11, Appl
18 2966.2 99.4 3311 15 US-10-394-087-12 Sequence 12, Appl
19 2966.2 99.4 3311 15 US-10-394-087-46 Sequence 46, Appl
20 2966.2 99.4 3311 15 US-10-394-087-47 Sequence 47, Appl
21 2966.2 99.4 3311 15 US-10-106-698-1971 Sequence 1971, Ap
22 2814.2 94.8 2854 15 US-10-106-698-351 Sequence 351, Ap
23 2793.6 93.7 3109 15 US-10-106-698-2111 Sequence 2111, Ap
24 2743 92.0 2745 14 US-10-270-595-5 Sequence 5, Appli
25 2489.2 83.4 4569 10 US-09-867-034-3 Sequence 3, Appli
26 2489.2 83.4 4569 15 US-10-276-115-3 Sequence 1, Appli
27 1764 59.1 2931 14 US-10-270-595-1 Sequence 850, App
28 1512 50.7 1512 16 US-10-305-720-850 Sequence 53, Appl
29 1310.2 43.9 3169 9 US-09-981-353-53 Sequence 15, Appl
30 1310.2 43.9 3169 15 US-10-235-994-15 Sequence 31, Appl
31 1310.2 43.9 3204 15 US-10-345-680-31 Sequence 6, Appli
32 1310.2 43.9 3204 17 US-10-482-669-6 Sequence 33, Appl
33 1310.2 43.9 3218 15 US-10-087-080-33 Sequence 16, Appl
34 1308.6 43.9 3043 13 US-10-025-167-16 Sequence 18, Appl
35 1308.6 43.9 3181 13 US-10-025-167-18 Sequence 2, Appli
36 1307.8 43.8 2751 17 US-10-482-669-2 Sequence 33, Appl
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42 1304 43.7 3265 9 US-09-989-731-378 Sequence 378, App
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ALIGNMENTS

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; Sequence 25, Application US/09823356
; Patent No. US20010025098A1
; GENERAL INFORMATION:
; APPLICANT: Tang, Y. Tom
; APPLICANT: Bandman, Olga
; APPLICANT: Lal, Preeti
; APPLICANT: Hillman, Jennifer L.
; APPLICANT: Yue, Henry
; APPLICANT: Corley, Neil C.
; APPLICANT: Guegler, Karl J.
; APPLICANT: Kaser, Matthew R.
; APPLICANT: Baughn, Mariah R.
; APPLICANT: Shah, Purvi
; TITLE OF INVENTION: HUMAN MEMBRANE SPANNING PROTEINS
; FILE REFERENCE: PF-0489-1 CON
; CURRENT APPLICATION NUMBER: US/09/823,356
; CURRENT FILING DATE: 2001-03-30
; PRIOR APPLICATION NUMBER: 09/039,307
; PRIOR FILING DATE: 1998 March 13
; NUMBER OF SEQ ID NOS: 34
; SOFTWARE: PERL Program
; SEQ ID NO 25
; LENGTH: 3111
; TYPE: DNA
; ORGANISM: Homo sapiens
; FEATURE:
; NAME/KEY: misc feature
; OTHER INFORMATION: Incyte ID No. US20010025098A1 1737775
; US-09-823-356-25

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Query Match 100.0%; Score 2983; DB 9; Length 3111;
Best Local Similarity 100.0%; Pred. No. 0;
Matches 2983; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

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Qy 2221 TCGGAGGCTCAATTTGTGGCTTCTGATGTCCTCCAAATGCTCCATACCTGATCTCTTCCCA 2280
Db 2230 TCGGAGGCTCAATTTGTGGCTTCTGATGTCCTCCAAATGCTCCATACCTGATCTCTTCCCA 2289
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; Patent No. US20020160382A1
; GENERAL INFORMATION:
; APPLICANT: Lasek, Amy W.
; TITLE OF INVENTION: GENES EXPRESSED IN COLON CANCER
; FILE REFERENCE: PA-0038 US
; CURRENT APPLICATION NUMBER: US/09/981.353
; NUMBER OF SEQ ID NOS: 194
; SOFTWARE: PERL Program
; SEQ ID NO 191
; LENGTH: 3111
; TYPE: DNA
; ORGANISM: Homo sapiens
; FEATURE:

; NAME/KEY: misc feature
; OTHER INFORMATION: Incyte ID No. US20020160382A1 1737775CB1
US-09-981-353-191

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Best Local Similarity 100.0%; Pred. No. 0;
Matches 2983; Conservative 0; Mismatches 0; Indels 0; Gaps 0;

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APPENDIX C 36